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09/731,631	12/07/2000	Steven M. French	AUS920000800US1	1071
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IBM CORP (YA) C/O YEE & ASSOCIATES PC P.O. BOX 802333 DALLAS, TX 75380			EXAMINER NGUYEN, THANH T	
			ART UNIT 2444	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/731,631  
Filing Date: December 07, 2000  
Appellant(s): FRENCH ET AL.

\_\_\_\_\_  
Steven M.French, et al.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed September 8, 2006 appealing from the corrected 112 first paragraphs mailed August 19, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beelitz et al., (hereinafter Beelitz) U.S. Patent No. 6,182,275 in view of Barr et al., (hereinafter Barr) U.S. Patent No. 6,189,100.

5. As to claim 1, Beelitz teaches the invention as claimed, a method of selecting an operating system at a target device in communication with a server, comprising: initiating a network bootstrap program at the target device (col. 14, lines 66 to col. 15, line 5); sending a bootstrap list command from the target device to the server (col. 14, line 66 to col. 15, line?); receiving an operating systems list of at least one operating system prior to executing an operating system at the target device (col. 15, lines 1-7); and selecting a target operating system from the operating

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systems list (col. 15, lines 5-12, and col. 16, lines 30-40). But Beelitz does not explicitly teach the target device is to be remotely booted by the server. However, Barr teaches the target device is to be remotely booted by the server (see col.2, lines 40-57). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the Barr's into the computer system of Beelitz to because it would have to provided an efficient system that lets a client and server to exchange a shared encryption key using the secure remote boot process.

6.As to claim 2, Beelitz teaches the invention as claimed, further comprising: receiving instructions for the target operating system (col. 14, lines 57-65).

7.As to claim 3, Beelitz teaches the invention as claimed, further comprising: requesting the instructions for the target operating system from the server (col. 14, lines 65- 67).

8. As to claim 4, Beelitz teaches the invention as claimed, further comprising: booting the target operating system based on the instructions (col. 14, lines 60-65).

9.As to claim 5, Beelitz teaches the invention as claimed, wherein the operatin systems list includes a default operating system (col.?, lines 49-54).

10. As to claim 6, Beelitz teaches the invention as claimed, further comprising: relocating the network bootstrap program after the target operating system is selected (col.8, lines 40- 45).

11. As to claim 7, Beelitz teaches the invention as claimed, wherein the target operating system is determined from a configuration file of the target device (col.

18, lines 60-65, and lines 5-10).

12. As to claim 8, Beelitz teaches the invention as claimed, wherein the target operating system is selected by a user of the target device (see col.7, lines 35-54, and col. 15, lines 5- 12).

13. As to claim 9, Beelitz teaches the invention as claimed, further comprising: determining from a user profile, at least one-available operating system; and including the user-available operating system with the operating systems list (col.7, lines 35-56).

14. As to claim 10, Beelitz teaches the invention as claimed, further comprising: determining from a target device profile, at least one device-available operating system; and including the device-available operating system with the operating systems list (col.7, lines 49-56).

15. As to claim 11, Beelitz teaches the invention as claimed, including a computer program product in a computer usable medium for selecting an operating system at a target device, comprising: means for initiating network bootstrap program code at the target device (col. 14, lines 66 to col. 15, line 5); means for receiving a command requesting an operating systems list of at least one operating system (col. 14, line 66 to col. 15, line7); means for sending the operating systems list to the target device before an operating system is executed at the target device (col. 15, lines 1-7); and means for receiving a selection of a target operating system from the operating systems list (col. 15, lines 5-12, and col. 16, lines 30-40). But Beelitz does not explicitly teach the target device is to be remotely booted by the server. However, Barr teaches the target device is to be remotely booted by the

server (see col.2, lines 40-57). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the Barr's into the computer system of Beelitz to because it would have to provided an efficient system that lets a client and server to exchange a shared encryption key using the secure remote boot process.

16. As to claim 12, Beelitz teaches the invention as claimed, further comprising: means for sending the target operating system to the target device (col.7, lines 35-40).

17. As to claim 13, Beelitz teaches the invention as claimed, further comprising: means for determining a default operating system (col. 17, lines 10-19).

18. As to claim 14, Beelitz teaches the invention as claimed, further comprising: means for relocating the network bootstrap program code alter the target operating system is selected (col.8, lines 40-45).

19. As to claim 15, Beelitz teaches the invention as claimed, further comprising: means for determining the target operating system from a configuration file of the target device (col. 18, lines 5-10, and lines 60-67).

20. As to claim 16, Beelitz teaches the invention as claimed, further comprising: means for receiving the selection of the target operating system from a user of the target device (col. 15, lines 5-12).

21. As to claim 17, Beelitz teaches the invention as claimed, further comprising: means for determining at least one operating system available to the user (col.7, lines 35-56).

As to claim 18, Beelitz teaches the invention as claimed, including a network data

processing system comprising: means for initiating a network bootstrap program at a target device (col. 14, lines 66 to col. 15, line 5); means for sending a command requesting an operating systems list of at least one operating system (col. 14, line 66 to col. 15, line 7); means for receiving the operating systems list prior to executing an operating system at the target device (col. 15, lines 1-7); and means for selecting a target operating system from the operating systems list at the target device (col. 15, lines 5-12, and col. 16, lines 30-40).

But Beelitz does not explicitly teach the target device is to be remotely booted by the server. However, Barr teaches the target device is to be remotely booted by the server (see col.2, lines 40-57). It would have been obvious to one of ordinary Skill in the art at the time of the invention was made to implement the Barr's into the computer system of Beelitz to because it would have to provided an efficient system that lets a client and server to exchange a shared encryption key using the secure remote boot process.

22. As to claim 19, Beelitz teaches the invention as claimed, further comprising: means for receiving the target operating system at the target device (col. 15, lines 2-7).

23. As to claim 20, Beelitz teaches the invention as claimed, further comprising: means for executing the target operating system at the target device (col.5, lines 37-42).

24. As to claim 21, Beelitz teaches the invention as claimed, further comprising: means for relocating the network bootstrap program aider the target operating system is selected (col.8, lines 40-45).



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25. As to claim 22, Beelitz teaches the invention as claimed, further comprising: means for determining the target operating system from a configuration file of the target device (col. 18, lines 5-10, and lines 60-67).

26. As to claim 23, Beelitz teaches the invention as claimed, further comprising: means for determining the target operating system from input of a user of the target device (col.2, lines 9-17).

#### **(10) Response to Argument**

- Appellants argues that the combination of Beelitz and Barr is insufficient to support a rejection.
- In response to applicant argument is extent of explanation provided by Applicant in support of claims 1, 11, and 18. This response by Applicant is insufficient to satisfy the requirement of specific argument to have the claims consider for patentability; in accordance 37 C.F.R. 1.111 Applicant must distinctly and specifically point out "how the language of the claims patently distinguishes them from the references". Accordingly, a prima facie case of obviousness is maintained as set forth in the rejections.
- Appellant argues that Beelitz reference does not teach "Initiating a network program bootstrap program at the target device".
- Examiner respectfully disagrees. In response to applicant's argument Beelitz reference discloses the initiating a network bootstrap program at the target device as shown in col. 15, lines 1-5(the targeted computer system 137 is initially booted up to perform the operation).

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- Applicant argues that Barr references in this rejection would indicate the use of impermissible hindsight.
- In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
- Appellant argues that the mere ability to combine references is insufficient to support a rejection.
- In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the Barr's

into the computer system of Beelitz to because it would have to provided an efficient system that lets a client and server to exchange a shared encryption key using the secure remote boot process [see Barr, col.2, lines 32-34].

- Appellant argues that Beelitz does not teach "a user profile"
- Examiner respectfully disagrees. In response to applicant's argument Beelitz reference discloses a user profile as shown in col. 13, lines 55-57 (the SDRfiles would also include customer specific information such as the name and address).
- Appellant argues that Beelitz does not teach "the target operating system is selected by a user of the target device".
- Examiner respectfully disagrees. In response to applicant's argument Beelitz reference discloses the target operating system is selected by a user of the target device as shown in col.6, lines 35-46 (the entry for an operating system may includes a tag that indicates that the vendor offers a standard disk format with the operating system, the tag indicates the control system need to be presented to user and that the user needs to selected an option).
- Appellant argues that Beelitz does not teach "relocating the network bootstrap program after the target operating system is selected".
- Examiner respectfully disagrees. In response to applicant's argument Beelitz reference discloses relocating the network bootstrap program after the target operating system is selected as shown in col.6, lines 55-

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67 (the central master data base is that the lists generated by the control computer systems are compatible and Up-to-date (relocation)).

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/T. N./

Examiner, Art Unit 2444

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444

Conferees:

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451